#8 SMA 1/6/03

P&G Case 7882X

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of	:	
MARK ROBERT SIVIK, ET AL.	:	Confirmation No. 6728
Serial No. 09/660,175	:	Group Art Unit 1751
Filed September 12, 2000	:	Examiner Mruk, Brian P.

OFFICIAL

For ETHER-CAPPED POLY(OXYALKYLATED) ALCOHOL SURFACTANTS

Response to Election/Restriction

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Box ___
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action of December 10, 2002, the time for response being extended by 0-months. Account in the papers submitted herewith, please consider the following remarks.

REMARKS

The Examiner has required a restriction to Group I: Claims 1-15 and 32-35, drawn to an ether capped poly(oxyalkylated) alcohol, classified in class 510, subclass 421; Group II Claims 16-22, drawn to a first process for making an ether capped poly(oxyalkylated) alcohol, classified in class 510, subclass 475; or Group III: Claims 23-31, drawn to a second process for making an ether capped poly(oxyalkylated) alcohol, classified in class 510, subclass 475.

As discussed in MPEP §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

MPEP § 808.05(f) states that a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process as *claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process. * * * A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention (emphasis in original).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803.

Applicants traverse the Examiner's election/restriction requirement, argument to follow hereinafter, and elect Group I (Claims 1-15 and 32-35). Applicants reserve the right to file on the non-elected claim groups.

Applicants submit that the claimed invention of the present application does not meet the requirements set forth in 35 U.S.C. § 121. First, Applicants content that the Examiner has failed to establish a *prima facie* showing of undue burden because of separate classification. The cited classes for all three groups determined by the Examiner are of identical ***class*** and merely differ in ***subclass***. Applicants content that the claimed invention of the present application does not require a separate field of search. Applicants submit that the Examiner has also failed to show any of the elements discussed in MPEP § 808.02, which states "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."

Applicants submit that examination of Claims 16-22 and Claims 23-31 would not place an undue burden on the Examiner. Therefore, Applicants respectfully traverse the Examiner's Election/Restriction requirement.

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 121. Early and favorable action in the case is respectfully requested. If, prior to allowance, any outstanding issues exist, Applicants' attorney/agent would welcome the opportunity to resolve such issues via a phone interview.

Respectfully submitted,
MARK ROBERT SIVIK, ET AL.

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Date: January 2, 2003
Customer No. 27752

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1) Election/Restriction Response (3 pgs)

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Inventor(s): Sivik, et al.

S.N.: 09/660,175

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Case: 7882X

Comments:

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